



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/202,424 02/19/99 ORUS

H G-41

TM02/0521

ROLAND PLOTTEL
ROCKEFELLER CENTER STN
PO BOX 293
NEW YORK NY 10185-0293

EXAMINER

TREMBLAY, M

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/202424

Applicant(s)

Orus et al.

Examiner

Tremblay

Group Art Unit

2165

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/16/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 and 26-41 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 and 26-41 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Applicant: Orus et al.

Filing date: 2/19/99

Claim Rejections - 35 USC § 112

5 Claims 1 and 26-41 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

10 Re claims 1, 26, 29, 35, 36, 39 the recital of "and/or" renders the claims indefinite. "/" has no definite meaning. The construction ambiguously presents either an alternative to an alternative, or an addition to an alternative, making the claim indefinite. The "or" case of each of the claims presents non-equivalent alternatives, further rendering the claims indefinite under modern claim drafting practice. It will therefore not be sufficient to delete "and/" from each of the referenced claims in response to this rejection.

15 Claim 26 is essentially an improper multiple dependent claim constructed as a single claim. If, instead of using the and/or terminology, the Applicant had chosen one case for a first claim (e.g. "debited") a second case for a second claim (e.g. "credited") and a third case for a third claim (e.g. "debited and credited"), then wrote a multiple dependent fourth claim using "or" terminology for the cases of "card" and "data", and wrote a fifth multiple dependent claim, depending from the first four claims, using the "or" terminology for "value units" and "the identification number", the
20 examiner would reject the claim as an improper multiple dependent claim. The fifth claim under this scenario would have less permutations than Applicant's claim 26.

Claim Rejections - 35 USC § 102/103

25 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

30 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness
5 rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
10 manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35
U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the
time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the
15 obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly
owned at the time a later invention was made in order for the examiner to consider the applicability of 35
U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

20 Claims 1, 26, 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent
#5429,361 to Raven et al. ("Raven" hereinafter), or alternatively, are rejected under 35 U.S.C.
§ 103 as being unpatentable over Raven. Raven teaches a method having the following steps,
during a gambling operation:

25 reading data stored in a gambling card, particularly an identification number of the card
and data representing the value units debited/credited initially and during the preceding gambling
operations (see particularly column 10, line 38 - column 11, line 62), characterized by the
following steps:

30 electronically securing (see column 10, lines 14-15 and line 56) and exchanging data
between the machine and a database of the central processing unit by means linking the secured
network, particularly data representing the balance of the value units and the identification number
of the card; and

updating data at least twice during each use of the card (see column 11, lines 36-37) in a

gambling playing session and then checking that the data stored in the gambling card correspond (lines 47-63) to the data in the database in order to monitor the integrity of a system constituted by such a card, such a machine, the network, and the central processing unit.

On some the point of the "secured network" it is not clear whether the examiner should interpret this to mean that encryption is used to protect the network (which is one reasonable industry-accepted interpretation) or whether to interpret any nominal mention of electronic security in Raven as meeting the bare recitations of security in claims 1 and 26. Assuming that it is determined that the interpretation should be the latter, Examiner's position is that the claims remain unpatentable because a "secured network" is an obvious adaptation of the teachings of Raven. Official Notice is taken that secured networks are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a secured network with the Raven et al system, because this would protect the system from any unauthorized tampering with signals traveling between the Mastercom and the main computer, preventing theft of assets. Since Raven mentions security as a primary function of Mastercom (col. 2, line 48), this use is clearly suggested by the reference to a person of ordinary skill in the art who is well aware of the existence of secured networks. Were the secured networks not already reduced to practice, the Applicant's own disclosure would have been required to present voluminous details to enable the invention.

With respect to the amended claim language, it is also unclear whether Raven clearly teaches updating the card at least twice during a gambling session. This, however, is a well known feature of many other stored value card systems. Typically, there is some concern that an unethical user will take advantage of a card transaction (e.g. receive a vended product, or pay a bill), but disable the machine from updating the card to reflect the transaction. This is done in a myriad of ways, invented by many criminally creative individuals. A machine may be unplugged before update. A machine may be blocked from contacting one of the contacts on a smart card, e.g. using adhesive tape on a selected metal contact, preventing updates. A tether may be affixed to a card, so that it may be yanked from the machine at any time to interfere with writing to the card. The eject button may be pressed at the anticipated time of updating. Other unauthorized

methods are well known in the art. Solutions are also myriad. One includes writing all data twice, particularly balance data, so that if a machine is unplugged during a write procedure, it may be immediately ascertained, because the double-entry values will not match. This is an old and well known method. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to update the card twice during each gambling session as taught in Raven, because otherwise a user could unplug the machine and retrieve the card forcibly, using a tether, if a gambling session resulted in a net loss. This would prevent knowledgeable users from gambling, and pulling their cards from the machine if the session went poorly. Even if the machine was merely unplugged, upon reboot, the machine would not realize the card had not been updated, and the gambler would have avoided a loss, thus assuring only net gains are recorded on the card.

Claims 27-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #5429,361 to Raven et al. ("Raven" hereinafter), or alternatively, are rejected under 35 U.S.C. § 103 as being unpatentable over Raven. Raven teaches a method as described above, but fails to teach many of the details of a secured system as claimed in the dependent claims.

Re claims 27-29 and 40-41, see the discussion of writing each value twice. This same logic applies to writing twice, once locally and once centrally.

Re claims 30-35, and 38-39 the claims correspond to at least two notoriously well known encryption systems. Official Notice is taken that public key cryptography and DES, including the use of secret keys, and security modules which calculate authentication certificates (in each type of system) is old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use public key cryptography or DES to secure the financial transactions taught in Raven. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a known security module to calculate authentication certificates to authenticate the gambling card's certificate.

Re claim 37, this is a standard smart card function, found in text books on smart cards.

Conclusion


Examiner has addressed the Applicant's arguments and amendments in the statement of the rejection above.

5 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this
15 final action.

Voice

20 Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Vincent Millin, can be reached on (703) 308-1065. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

25
May 19, 2001